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RESTON, VA 20195

EXAMINER

MEHRA, INDER P

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,588	Applicant(s) ROLLENDER, DOUGLAS H.	
	Examiner INDER P. MEHRA	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-28 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-12, 29, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/09</u> . | 6) <input type="checkbox"/> Other: _____ |

1. This office action is in response to amendment dated: 12/5/2008. Based on this amendment, claims 1-32 are pending. Claims 1-3, 6-7, 11-16, 18, 20, 24, 26, 31 have been amended. Claim 32 has been added anew.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 2/13/2009 was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12, 29-30 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Refer to claim 1, lines 5-6. Limitation "the first portion of the received data differing from a user identification number" is not supported by specifications. Similar problem exists in claim 32. Page no. and line number be quoted, please.

Art Unit: 2617

Refer to claim 11 (amended) , lines 2-3 of amended claim. Limitation “wherein the forming a modified first permanent identifier step forms the modified first permanent identifier to further include destination entity routing information indicating to which destination entity to route the first permanent identifier” is not supported by specifications. Page no. and line number be quoted, please. Further, “identifier”, in line 2 should be spelled “identifier”.

Appropriate correction/clarification is required.

Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-12, 29-30 and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Admitted Prior Art** of instant application, hereinafter, **APA** in view of **Non Patent**

Literature (Mobile IP by James D. Solomon, 1998 Prentice Hall PTR, Prentice Hall, Inc., pages 54-56, dated 9/5/1997), **hereinafter, Solomon, and,** further, in view of **Willey** (US Patent No. 6,505, 058), hereinafter, Willey.

For claim 1, APA discloses, a method of transferring data in mobile communication system, **(APA teaches in reference to fig. 1 (Prior Art) and paragraphs 0008-0016, a system and process to transfer data in mobile communication system by opening a traffic channel to the destination entity, paragraph 0016)comprising:**

receiving data to be transferred to a destination entity; **(data is supplied by end user 2 using first communication device 4, paragraph 0016);**

forming a modified first permanent identifier including a portion of the received data and routing information to a home system,” the first portion of the received data differing from a user identification number **(APA discloses first permanent identifier including first portion as routing information to a home system, such as mobile country code (MCC) and mobile network code (MNC), paragraphs 0008-0009, this first portion of identifies does not user identification, rather location or region identification, and second portion identifies end user 2 to home system 16, paragraph 0008). Note: Applicant claims “portion of receiving data” as part of first permanent identifier in addition to routing information to home system. Applicant does not specify type of data, thus data is generic (broad definition) without type. Identification number of end user 2, as disclosed by APA in paragraph 0008 is a type of data in addition to routing information.**

However, Solomon (published on 9/15/1997) teaches ‘receiving data”, per se, in addition to header information, (which is standard) as explained below separately:

forming an expanded second permanent identifier having a second permanent identifier portion and an expanded portion, and the expanded portion including a portion of the received data; the first portion of the received data differing from a user identification number **(APA discloses expanded second permanent identifier, paragraph 0011, including three portion. The first two portions are the second permanent identifier, as claimed, such as electronic serial number of mobile communication device 4, paragraph 0013, and third portion represents unexpanded portion of second permanent identifier, which is associated with communication device 4 or being used by the end user 2, paragraphs 0010-0011. Note: Applicant claims “portion of receiving data” as part of expanded second permanent identifier in addition to second permanent identifier portion. This limitation (data) is the same as part of first permanent identifier. Applicant does not specify type of receiving data again, thus receiving data is generic without type. APA discloses third identification number as expanded portion of expanded second permanent identifier, paragraph 0012.**

However, Solomon teaches ‘receiving data’, per se, in addition to header information, (which is standard) as explained below separately:

sending, from a communication device, at least the first permanent identifier and the expanded second permanent identifier. **(APA discloses, communication device 4 connected to the service system 12, fig. 1, provides both first and expanded permanent identifiers to home system 16 to validate end user 2, paragraphs 0014-0015).**

Solomon teaches receiving data (payload) in addition to routing information (header providing IP address) , virtual link (routing information) to Home Agent, page 54.

APA in view of Soloman does not teach the following limitation, which is disclosed by Willey, as follows:

“modified first permanent identifier---”.(Willey discloses “modifier called Decorr, col. 13 lines 3-7).

It would have been obvious to the person of ordinary skill in the art at the time of the invention to use the receiving address as portion of first permanent identifier and expanded permanent identifier, as taught by APA and Solomon. The receiving data could be implemented by incorporating receiving identifier into first and expanded permanent identifiers. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

For claim 32, **APA teaches in reference to fig. 1 (Prior Art) and paragraphs 0008-0016a method of receiving data in a mobile communication system, (APA teaches in reference to fig. 1 (Prior Art) and paragraphs 0008-0016, a system and process to transfer data in mobile communication system by opening a traffic channel to the destination entity, paragraph 0016), comprising:**

receiving a modified first permanent identifier including a first portion of user generated data **(data is supplied by end user 2 using first communication device 4, paragraph 0016);** and routing information to a home system, the first portion of the user generated data differing from a user identification number; and

(APA discloses first permanent identifier including first portion as routing information to a home system, such as mobile country code (MCC) and mobile network code (MNC), paragraphs 0008-0009, this first portion of identifies does not user

Art Unit: 2617

identification, rather location or region identification, and second portion identifies end user 2 to home system 16, paragraph 0008). Note: Applicant claims “portion of receiving data” as part of first permanent identifier in addition to routing information to home system. Applicant does not specify type of data, thus data is generic (broad definition) without type. Identification number of end user 2, as disclosed by APA in paragraph 0008 is a type of data in addition to routing information.

However, Solomon (published on 9/5/1997) teaches ‘receiving data’, per se, in addition to header information, (which is standard) as explained below separately:

receiving a modified expanded second permanent identifier having a second permanent identifier portion and an expanded portion, the expanded portion including a second portion of user generated data.

(APA discloses expanded second permanent identifier, paragraph 0011, including three portion. The first two portions are the second permanent identifier, as claimed, such as electronic serial number of mobile communication device 4, paragraph 0013, and third portion represents unexpanded portion of second permanent identifier, which is associated with communication device 4 or being used by the end user 2, paragraphs 0010-0011.

Note: Applicant claims “portion of receiving data” as part of expanded second permanent identifier in addition to second permanent identifier portion. This limitation (data) is the same as part of first permanent identifier. Applicant does not specify type of receiving data again, thus receiving data is generic without type. APA discloses third identification number as expanded portion of expanded second permanent identifier, paragraph 0012.

However, Solomon teaches ‘receiving data’, per se, in addition to header information, (which is standard) as explained below separately:

Solomon teaches receiving data (payload) in addition to routing information (header providing IP address) , virtual link (routing information) to Home Agent, page 54.

APA in view of Soloman does not teach the following limitation, which is disclosed by Willey, as follows:

“modified first permanent identifier---”.(Willey discloses “modifier called Decorr, col. 13 lines 3-7).

It would have been obvious to the person of ordinary skill in the art at the time of the invention to use the receiving address as portion of first permanent identifier and expanded permanent identifier, as taught by APA and Solomon, and “modified first permanent identifier---”, as taught by Willey. The receiving data could be implemented by incorporating receiving identifier into first and expanded permanent identifiers. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

For claims 2-3, **APA in view of Solonam and Willey**, discloses all limitations of subject matter, as applied to claim 1, as above. In addition, APA disclose the following limitations:

Wherein the step a) receives data from a user of the communication device (see claim 2); (data is supplied by end user 2 using first communication device 4, paragraph 0016);

Wherein the step a) receives data from an user system including or connected to the communication device (see claim 3); (data is supplied by end user 2 connected to communication device 4) using first communication device 4, paragraph 0016 and fig. 1);

APA does not teach following limitations, which are disclosed by Solomon, as follows:

Solomon teaches receiving data (payload) in addition to routing information (header providing IP address) , virtual link (routing information) to Home Agent, page 54.

It would have been obvious to the person of ordinary skill in the art at the time of the invention to use the receiving address as portion of first permanent identifier and expanded permanent identifier, as taught by APA and Solomon. The receiving data could be implemented by incorporating receiving identifier into first and expanded permanent identifiers. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

For claim 11, **APA in view of Solonam and Willey**, discloses all limitations of subject matter, as applied to claim 1, as above. In addition, APA disclose the following limitations:

wherein the forming a --- first permanent identifier step forms the modified first permanent identifier to further include destination entity routing information indicating to which destination entity to route the first permanent identifier (APA teach first and second permanent identifiers, paragraph 0015; further, teaches, destination entity, APA ' paragraph 0016 (background)).

For claims 4-10. APA in view of Solomon and Willey teaches all the limitations of subject matter, as applied to claim 1 for claims 4 and 7-10 respectively; claims 1 and 4 for claims 5-6 respectively. In addition, **APA** teaches for claims 4-10, as follows:

wherein the communication device is a mobile station **(see claim 4), (APA paragraph 0004).**

wherein the routing information includes a mobile country code and a mobile network code, **(see claim 5), (APA paragraph 0009).**

wherein the--- expanded second permanent identifier is an expanded electronic serial number of the mobile station **(see claim 6) . (paragraph 0010).**

wherein the--- expanded second permanent identifier is associated with at least a part of the communication device **(see claim 7). (APA teaches, the expanded second permanent identifier includes second permanent identifier ,which is electronic serial number (ESN) associated with at least a part of the communication device, paragraph 0010).**

wherein the routing information includes a mobile country code and a mobile network code **(see claim 8). (paragraph 0008).**

wherein the communication device forms part of a wireless communication system **(see claim 9). (paragraph 0003 and fig. 1)..**

wherein the communication device forms part of a wireline communication system **(see claim 10). (APA teaches, communication device as part of wireline communication system, paragraph 0005 and fig. 1).**

For claim 12, **APA in view of Soloman and Willey** discloses all the limitations of subject matter, as applied to claim 11, with the exception of the following limitations which are disclosed by **Solomon**, as follows:

wherein the forming a--- expanded permanent identifier step forms the expanded portion to further include destination entity routing information indicating to which destination entity to route the expanded second permanent identifier (**Solomon teaches header called original IP Packet, page 54 and fig. 4-2, which includes “ultimate destination” is part of expanded portion of expanded permanent identifier. This ultimate destination means destination entity, as claimed**).

It would have been obvious to the person of ordinary skill in the art at the time of the invention to include the expanded portion to further include destination entity routing information indicating to which destination entity to route the expanded second permanent identifier as taught by Solomon. This capability could be implemented in the expanded portion of the expanded second permanent identifier of APA. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

For claim 29, **APA in view of Soloman and Willey** discloses all the limitations of subject matter, as applied to claim 1, with the exception of the following limitations which are disclosed by **Solomon**, as follows:

wherein the received data is not used to validate an end user of the communication device **(Solomon teaches header called original IP Packet, page 54 and fig. 4-2, which includes “received data is not used to validate an end user of the communication device” is part of expanded portion of expanded permanent identifier.**

It would have been obvious to the person of ordinary skill in the art at the time of the invention to include the received data is not used to validate an end user of the communication device as taught by Solomon. This capability could be implemented in the expanded portion of the expanded second permanent identifier of APA. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

For claim 30, **APA in view of Soloman and Willey** discloses all the limitations of subject matter, as applied to claim 1, with the exception of the following limitations which are disclosed by **Solomon**, as follows:

wherein the received data is not identification information associated with the communication device or an end user of the communication device. **(Solomon teaches header called original IP Packet, page 54 and fig. 4-2, which includes “the received data is not identification information associated with the communication device or an end user of the communication device” is part of expanded portion of expanded permanent identifier.**

It would have been obvious to the person of ordinary skill in the art at the time of the invention to include “the received data is not identification information associated with the communication device or an end user of the communication device” as taught by Solomon. This

Art Unit: 2617

capability could be implemented in the expanded portion of the expanded second permanent identifier of APA. The motivation for using this capability was to transmit data more efficiently than lengthy process of requesting and establishing a traffic channel.

Allowable Subject Matter

7. Claims 13-28 and 31 are allowed.

Response to Arguments

8. Applicant's arguments with respect to claims 1-32 have been considered but are not persuasive in view of the new ground(s) of rejection, as follows:.

Applicant's argument

Regarding publication date of Solomon (NPL), applicant argues, "As a preliminary matter, Applicants submit that the record does not contain any evidence regarding the publication date of cited art which is relied upon by the Office Action for rejections. Specifically, Non-Patent Literature (Mobile IP by James D. Solomon, allegedly 1998 Prentice Hall PTR, Prentice Hall, Inc., pages 54-56), hereinafter "Solomon") does not contain any evidence of the alleged publication date of 1998. A mere statement by the Examiner baldly asserting a publication date is not proper evidence. Please note that pages 54 and 55 of Solomon are presented as pages 19 and 20 of the Office Action, but do not contain any evidence of the publication date. **Thus, Applicants request that the Examiner provide written evidence supporting the publication date, or else withdraw all rejections which rely upon Solomon.**

Examiner's response

Publication date is 8/5/1997, which is prior to the effective filing date 3/3/1999. Copy of cover (pages 1-3) and NPL, pages 54-56, are enclosed for ready reference. For the publishing date, refer to page 3 of cover, enclosed, herewith.

Applicant's argument

In order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art.

Independent claim 1 recites, in part, "forming a modified first permanent identifier including a first portion of the received data and routing information to a home system, **the first portion of the received data differing from a user identification number.**" As an illustrative and non-limiting example of claim i, the first permanent identifier may be modified by inserting a first portion of the received data. See paragraphs [0028] to [0031] in the present application for additional discussion. As an illustrative and non-limiting example of claim 1, the second portion of a first permanent identifier ordinarily contains the user identification number pre-assigned by the home system, but a modified first permanent identifier may contain a first portion of the received data in the second portion of the modified first permanent identifier (instead of the user identification number).

Examiner's response

In response, examiner states that Willey discloses “modifier called Decorr to IMSI, refer to col. 13 lines 3-7. Note: IMSI is the first permanent identifier (refer to paragraph 0009 of specification of instant application.

In light of above explanation, arguments by applicant are not persuasive.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed toINDER P. MEHRA whose telephone number is (571)272-3170. The examiner can normally be reached on Monday through Friday from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Inder P Mehra/
Examiner, Art Unit 2617

/Dwayne D. Bost/
Supervisory Patent Examiner,
Art Unit 2617